



AG/ 1733

18

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent application of:

Applicant: Dieter Dohring
Serial No.: 09/647,130
Filing Date: March 5, 2001
Title: METHOD OF PRODUCING LAMINATE COATINGS, AND
LAMINATE COATING

Examiner: Justin R. Fischer
Art Unit: 1733

Docket No. TURKP0113US

APPELLANT'S REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This brief is submitted in reply to the Examiner's Answer dated December 1, 2004.

Newly Applied/Cited Werz U.S. Patent No. 4,153,490

In the Examiner's Answer, the Examiner for the first time cites and relies on Werz U.S. Patent No. 4,153,490 (hereinafter Werz), which was not previously of record in the subject application. The rejections have not been restated, but the Examiner introduces Werz in his response to the arguments presented in appellant's main brief.

37 CFR 1.193(a)(2) prohibits the entry of a new ground of rejection in an examiner's answer. At the time of preparing the answer to an appeal brief, an examiner

may decide that he or she should apply a new ground of rejection against some or all of the appealed claims. In such an instance where a new ground of rejection is necessary, the examiner normally should reopen prosecution.

On the other hand, there is no new ground of rejection when the basic thrust of a rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. Where the statutory basis for the rejection remains the same, and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection. For instance, reliance upon fewer references under 35 U.S.C. 103 does not constitute a new ground of rejection.

In the present case, the Examiner is relying on an additional reference as evidence. The Examiner stated:

To further evidence the use of papers and fleeces as protective layers for decorative laminates, see Werz (Column 1, Lines 55-60). Werz specifically details the common use of overlay papers and glass fiber fleeces in the manufacture of surface protective layers for laminate assemblies.

Thus, it appears that prosecution should be reopened to allow appellant the opportunity to respond to the new evidence on which the Examiner relies.

Claim Interpretation

The Examiner's contention that claim 1 is anticipated by Lindgren is premised on a "covering layer of fibre material" encompassing the paper overlay sheet of Lindgren. The Examiner contends that applicant has not provided a definition or description for such a layer that would define over the paper overlay sheet of Lindgren. To the

contrary, it is apparent from the specification that the therein described covering layer of fibre material is not a paper sheet.

At the top of page 2 of the specification, a prior art process is described as follows:

It is further known to produce laminate coatings for floor tiles in such a way that an upper or visible face of a decorative paper impregnated with amino acid or melamine resin there is applied an overlay which has on the upper surface of a substrate made of paper the fine particles of aluminium oxide or corundum which provide the wear resistance.

This is to be contrasted with the subsequent discussion of the invention on page 3 at lines 18-26:

The material covering layer of fibre material containing melamine resin applied to the impregnated decorative paper after the spreading of the particulate aluminium oxide is transparent, so that the pattern on the decorative paper is clearly visible.

and the paragraph spanning pages 3 and 4:

In other words the surface of the laminate coating produced in accordance with [the] invention remains clear because the fibre fleece applied as encapsulation for the corundum particles does not alter or adversely affect the visibility of the pattern on the paper, but on the other hand protects the pressing plates or pressing bands of the presses or other production machines used for the manufacture of the laminate coating against premature wear.

The above discussion of the invention vis-a-vis the previously discussed prior art would make no sense if the "covering layer of fibre material" encompassed a paper overlay. Rather, it is apparent that such term is used to describe a layer of fine, slender thread, or threadlike substances,¹ such as a fleece, and not a paper which, although often made of cellulose fibres, does not have the appearance or characteristics of a fibre material, like fleece.

¹ See the dictionary definition provided in appellant's main brief.

Lindgren

On page 3 of the Examiner's Answer, the Examiner notes that ***Lindgren*** describes the overlay paper as a "wet fiber layer" and a "whole fiber layer". The Examiner is correct that ***Lindgren*** does use these terms, but he fails to point out that these terms are used in relation to the formation of the overlay paper during a process separate from when the overlay paper is layed up with a decor paper.

According to Example 2 of ***Lindgren*** wherein such terms appear, an overlay paper is first made in a paper mill by feeding suspended cellulose fibers from a head box to the wire of the paper mill. Aluminum oxide particles are then applied to the upper side of the wet fiber layer. Manufacture of the overlay paper is then completed, whereupon the aluminum oxide particles will be embedded in the finished overlay paper.

The finished overlay paper is then impregnated with melamine-formaldehyde resin and thereafter treated in the same way as according to Example 1. According to Example 1, the impregnated overlay paper is pre-dried to form a prepreg. Likewise, an impregnated decor paper is pre-dried to form a prepreg. The decor paper prepreg, overlay paper prepreg, and three kraft paper prepreps are placed in a press and heated under pressure to form a laminate.

The foregoing process is not at all similar to the process set forth in claim 1. According to claim 1, a wet patterned or decorative paper impregnated with a melamine resin has particulate fine aluminum oxide (corundum) spread thereon while still wet. The paper is then pre-dried or pre-condensed. Then a covering layer of fibre material containing melamine resin is applied onto the pre-treated paper. The whole is finally dried in a second drying step. The resultant composite is then ready to be pressed

and heated in a press to form a laminate, wherein the covering layer is transparent for viewing of the patterned or decorative paper.

The differences between the two processes perhaps is best illustrated by the following table comparing the steps of the two processes.

Claim 1	Lindgren Example 2
A process for producing laminate coatings comprising the steps of:	
a) taking a wet patterned or decorative paper impregnated with a melamine resin;	A decor paper is impregnated with melamine-formaldehyde resin, and then pre-dried to form a prepreg
b) spreading particulate fine aluminum oxide (corundum) onto the still wet paper before drying to pre-treat said paper;	Aluminum oxide particles are not applied to the decor paper when still wet and before pre-drying. Instead, aluminum oxide particles are embedded in an overlay paper that is separately formed in a paper mill. The finished overlay paper with the particles embedded therein is then impregnated with melamine-formaldehyde resin and the pre-dried to form a prepreg
c) pre-drying or pre-condensing said paper;	There is no pre-drying or pre-condensing of the wet decor paper after aluminum oxide particles have been spread thereon.
d) applying a covering layer of fibre material containing melamine resin onto said pre-treated paper; and	The overlay paper prepreg and decor paper prepreg are assembled together.
e) finally drying the whole, with the covering layer being transparent for viewing of the patterned or decorative paper.	The assembled prepreps are then pressed. There is no further drying step.

Clearly, **Lindgren** falls short of disclosing a method as set forth in claim 1 and, consequently, the rejection of claim 1 under 35 U.S.C. 102 cannot be sustained.

The Examiner's additional reliance on **Veneziale** does not resolve the fundamental deficiency of **Lindgren** as a teaching reference vis-a-vis the claimed subject matter. The Examiner relies on **Veneziale** for a suggestion of using a variety of fibrous webs or layers, such as mats, rovings, yarns, woven goods, and paper sheet-like layers, as top layers in the manufacture of decorative laminates. Even if this is accepted as a general premise, there is lacking any suggestion or motivation as to how to apply this general premise to **Lindgren** in a manner that would give rise to the subject matter of applicant's claims. Applying this premise to Example 2 of **Lindgren** upon which the Examiner relies, the result would be a substitution of the specially fabricated overlay prepreg with a fibrous layer. This substitution leaves many variables for which no guidance is provided. For instance, will the fibrous layer be impregnated with a melamine resin and then pre-dried to form a prepreg, or will the fibrous layer be pre-processed in some manner to contain aluminum oxide particles and then pre-dried to form a prepreg? Even if answers existed for these questions, it is not seen how the result would yield the subject matter of claim 1 without deviating fundamentally from the teachings of **Lindgren**.

According to the Examiner's interpretation of **Lindgren**, **Lindgren** is primarily directed to the inclusion of hard particles on at least one side of a decorative paper. Actually, the problem addressed by **Lindgren** is the uneven distribution of wear-enhancing hard particles in a decorative laminate. **Lindgren** discloses how to solve this problem by using, in particular, a specially processed overlay paper as above discussed. **Veneziale**, filed almost 20 years prior to **Lindgren**, has nothing to do with the problem. **Veneziale**, offers no guidance on how to modify the methodology of **Lindgren** for use with a covering layer of fiber material while still achieving the desired

goal of improved wear without sacrificing appearance, or vice versa. Only appellant's specification directs how one might successfully combine bits and pieces of **Lindgren** and **Veneziale**.


Conclusion

For the reasons discussed above and those set forth in appellant's main brief, the rejections should be reversed. Moreover, given the Examiner's reliance on additional evidence, prosecution properly should be reopened to allow for an appropriate response to the new evidence. For purposes of this reply brief, it is assumed that no reliance can be had on such new evidence until prosecution is reopened.

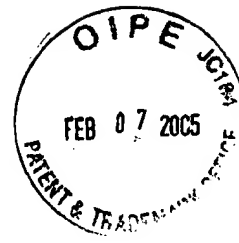
In the event any fee or additional fee is due in connection with the filing of this paper, the Commissioner is authorized to charge those fees to our Deposit Account No. 18-0988 (under the above Docket Number). In the event an extension of time is needed to make the filing of this paper timely and no separate petition is attached, please consider this a petition for the requisite extension and charge the fee to our Deposit Account No. 18-0988 (under the above Docket Number).

Respectfully submitted,

RENNER, OTTO, BOISSELLE & SKLAR, LLP

By 
Don W. Bulson, Reg. No. 28,192


1621 Euclid Avenue
Nineteenth Floor
Cleveland, Ohio 44115
(216) 621-1113



CERTIFICATE OF MAILING (37 CFR 1.8a)

I hereby certify that this paper (along with any paper or thing referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: February 1, 2005


Don W. Bulson

H:\DWB\TURK\IP0113\IP0113US.R09 (reply brief).wpd